

REMARKS

Claims 1 and 18 have been amended to incorporate the subject matter of Claims 3 and 20, respectively. Support is found in the claims as originally presented.

Claim 1 has also been amended to recite that all claimed steps be performed within approximately 90 minutes. Support for the claim as amended is found on page 4, third paragraph, page 5, first paragraph, and page 11, third paragraph.

New Claim 30, which recites that all steps in Claim 1 be performed within approximately 60 minutes has been inserted. Support for the claim as amended is found on page 4, third paragraph, page 5, first paragraph, and page 11, third paragraph.

Claims 2, 3, 13-16, 19, and 20 have been canceled without prejudice.

Claims 4-7, 17, and 21-24 have been amended according to the amended antecedents in Claims 1 and 18.

Claims 1, 4-12, 17-18, and 21-30 are pending. Favorable reconsideration is respectfully requested.

No new matter is added.

Amendment of the Specification

The amended paragraph in the specification corrects a typographical error present in the original specification. The amended specification identifies the correct figure corresponding with the text.

No new matter is added.

Rejection of Claims 13-16 under 35 U.S.C. §112, Second Paragraph

Claims 13-16 have been canceled without prejudice. Therefore, this rejection has been rendered moot.

Withdrawal of this rejection is respectfully requested.

Rejection of Claims 1-2, 7-8, 10-12, 17-19, 24-25, 27-28, and 29 under 35 U.S.C. §103(a) over Basbøll (U.S. Pat. No. 5,648,227) in view of Bronstein et al. (U.S. Pat. No. 6,586,196) and Chen et al. (U.S. Pat. No. 6,355,449).

This rejection has been overcome by amendments to the claims.

Claims 1 and 18 have been amended to incorporate the subject matter of Claims 3 and 20, respectively. Claims 3 and 20, which previously defined the inert surface in Claims 1 and 18 as a magnetic particle, were not subject to this rejection. By incorporating this additional element into independent Claims 1 and 18, these claims and all claims dependent thereon are no longer subject to this rejection.

Claim 1 has been additionally amended to recite that the claimed steps (*e.g.*, steps (a) through (e)) be performed within approximately 90 minutes. None of the methods described in the prior art cited in this rejection either require or suggest that the methods be performed within approximately 90 minutes. By incorporating this additional element into Claim 1, Claim 1 and all claims dependent thereon are rendered free of this rejection.

Applicant submits that this rejection has been overcome. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 5 and 22 under 35 U.S.C. §103(a) over Basbøll (U.S. Pat. No. 5,648,227) in view of Bronstein et al., Chen et al., and Prober et al. (U.S. 2005/0019842).

This rejection has been overcome by amendments to the claims.

Claim 5 depends from Claim 1, and Claim 22 depends from Claim 18. Claims 1 and 18 have been amended to incorporate the subject matter of Claims 3 and 20, respectively. Claims 3 and 20, which previously defined the inert surface in Claims 1 and 18 as a magnetic particle, were not subject to this rejection. By incorporating this additional element into independent Claims 1 and 18, all claims dependent thereon, including Claims 5 and 22, are rendered free of this rejection.

Claim 1 has been additionally amended to recite that the claimed steps (*e.g.*, steps (a) through (e)) be performed within approximately 90 minutes. None of the methods described in the prior art cited in this rejection either require or suggest that they be performed within approximately 90 minutes. By incorporating this additional element into independent Claim 1, all claims dependent thereon, including Claim 5, is rendered free of this rejection.

Applicant submits that this rejection has been overcome. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 3-6 and 20-23 under 35 U.S.C. §103(a) over Basbøll (U.S. Pat. No. 5,648,227) in view of Bronstein et al., Chen et al., Giaever (U.S. Pat. No. 3,970,518), and Gruttner et al. (*Journal of Magnetism and Magnetic Materials* 2001).

This rejection with respect to Claims 3-6 and 20 has been overcome by cancellation of Claims 3 and 20 and amendments to Claims 4-6.

Claims 3 and 20 were cancelled without prejudice with regard to their merits. Claims 4-6 remain dependent on Claim 1. Claim 1 was amended to recite that the claimed steps (*e.g.*, steps (a) through (e)) be performed within approximately 90 minutes. None of the methods described in the prior art cited in this rejection either require or suggest that they be performed within approximately 90 minutes. By incorporating this additional element into independent Claim 1, all claims dependent thereon, including Claims 4-6, are rendered free of this rejection. Applicant therefore submits that this rejection has been overcome with respect to Claims 4-6.

This rejection is respectfully traversed with respect to Claims 21-23. Applicant submits the combination of references is improper because there is no motivation to combine them. For example, the Examiner has stated that one of ordinary skill in the art would have been motivated to detect the immobilized *Listeria spp.* of Basbøll using the β -glucosidase substrate and enhancer taught by Bronstein et al., with the expectation of **detection of the immobilized *Listeria* microorganism** quickly, with high sensitivity, and with a reasonable expectation of success. However, there is nothing in the Bronstein et al. reference to suggest detecting the presence of a microorganism using the β -glucosidase substrate and enhancer. The method and kit of Bronstein et al. is directed to detecting β -glucosidase activity as an internal control for detecting the activity of other enzymes, such as reporter enzymes. There is no mention of detecting any microorganism, including *Listeria*, in Bronstein et al. In addition, the detection of a microorganism in a sample requires comparison of a diagnostic indicator in a given sample with **other samples** including positive and negative controls (*e.g.*, a sample containing the microorganism and a sample not containing the microorganism). The detection of β -glucosidase in the method and kit of Bronstein et al. provides only a value of enzyme activity for comparison with another enzyme in a **single sample** (col. 3, line 64). There is

no suggestion in Bronstein et al. to compare β -glucosidase activity across samples or how one would perform the comparison. Because there is no suggestion in Bronstein et al. that one would use the method to detect microorganisms or even how one would perform the detection, Applicants submit that there is no motivation to combine this reference in the current rejection.

Applicants also submit that the combination of references provides no reasonable expectation of success in detecting immobilized *Listeria monocytogenes* cells. There is no indication in any of the cited prior art that immobilization of the *Listeria spp.* cells on an inert surface in an *in vitro* environment would affect β -glucosidase enzyme activity. Basbøll, Giaever, and Gruttner et al. are completely silent on methods of detecting enzyme activity. Chen et al. determine β -glucosidase enzyme activity in an environment conducive to the growth of cells such that the cells are freely maintained in a medium containing nutrients necessary to support bacterial growth (col. 4, lines 5-7). Detection of enzyme activity in such an environment fails to indicate the success of detecting β -glucosidase enzyme activity of immobilized cells in the absence of growth medium. Finally, Bronstein et al. may employ β -glucosidase enzyme detection, but the method is not performed on immobilized microorganisms. Thus, there is no predictor of the likelihood of success with the current method or kit employing the method. Applicant therefore concludes that the combination of references provides no reasonable expectation of success with the current method or kit employing the method.

Applicant submits that there is no motivation to combine the all of the references required for the rejection and that their combination provides no expectation of success with the current method or kit. Applicant therefore submits that the rejection with respect to Claims 21-23 is untenable.

Withdrawal of the rejection is respectfully requested.

Rejection of Claims 9 and 26 under 35 U.S.C. §103(a) over Basbøll (U.S. Pat. No. 5,648,227) in view of Bronstein et al., Chen et al., and Giri et al. (U.S. Pat. No. 6,767,716).

This rejection has been overcome by amendments to the claims.

Claim 9 depends from Claim 1, and Claim 26 depends from Claim 18. Claims 1 and 18 have been amended to incorporate the subject matter of Claims 3 and 20, respectively. Claims 3 and 20, which previously defined the inert surface in Claims 1 and 18 as a magnetic particle, were not subject to this rejection. By incorporating this additional element into independent Claims 1 and 18, all claims dependent thereon, including Claims 9 and 26, are rendered free of this rejection.

Claim 1 has been additionally amended to recite that the claimed steps (*e.g.*, steps (a) through (e)) be performed within approximately 90 minutes. None of the methods described in the prior art cited in this rejection either require or suggest that they be performed within approximately 90 minutes. By incorporating this additional element into independent Claim 1, all claims dependent thereon, including Claim 9, is rendered free of this rejection.

Applicant submits that this rejection has been overcome. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 13-16 under 35 U.S.C. §103(a) over Basbøll (U.S. Pat. No. 5,648,227) in view of Bronstein et al., Chen et al., Batt et al. (U.S. Pat. No. 5,294,537, Gangne et al. (*Journal of Clinical Microbiology* 1998), Gilpatrick et al. (*Journal of Virology* 2000), and Bao et al. (*Biological Procedures Online* 2002).

This rejection has been overcome by amendments to the claims.

Claims 13-16 all ultimately depend from Claim 1. Claim 1 has been amended to incorporate the subject matter of Claim 3. Claim 3, which previously defined the inert surface in Claim 1 as a magnetic particle, was not subject to this rejection. By incorporating this additional element into independent Claim 1, all claims dependent thereon, including Claims 13-16, are rendered free of this rejection.

Claim 1 has been additionally amended to recite that the claimed steps (*e.g.*, steps (a) through (e)) be performed within approximately 90 minutes. None of the methods described in the prior art cited in this rejection either require or suggest that they be performed within approximately 90 minutes. By incorporating this additional element into independent Claim 1, all claims dependent thereon, including Claims 13-16, are rendered free of this rejection.

Applicant submits that this rejection has been overcome. Withdrawal of the rejection is respectfully requested.

New Claim 30

Claim 30, which recites that all steps in Claim 1 be performed within approximately 60 minutes, has been inserted. None of the methods described in the prior art either require or suggest that they be performed within approximately 90 minutes. Applicant submits that this claim is therefore in condition for allowance. Favorable consideration is respectfully requested.

CONCLUSION

Applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited.

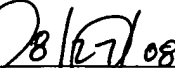
Respectfully submitted,


Joseph T. Leone, Reg. No. 37,170
CUSTOMER NO.: 25005
Intellectual Property Department
DEWITT ROSS & STEVENS S.C.
2 East Mifflin Street, Suite 600
Madison, WI 53703-2865
Telephone: (608) 255-8891
Facsimile: (608) 252-9243

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Date of Deposit:



Signature:

